

Remarks

The Final Office Action dated October 19, 2009, presents the following rejections: claims 1-2, 4-5 and 9-10 stand rejected under 35 U.S.C. § 103(a) over MacLellan (U.S. Patent No. 5,940,006) in view of Shigyo (U.S. Patent No. 6,430,209) and further in view of Thierry (WO 99/60510); claims 3, 8, 13 and 18 stand rejected under 35 U.S.C. § 103(a) over the '006, '209 and '510 references in view of the Okumura reference (U.S. Patent No. 2003/0003942); and claims 20-26 stand rejected under 35 U.S.C. § 102(b) over the '510 reference. In the following discussion, Applicant does not acquiesce in any regard to averments in this Office Action (unless Applicant expressly indicates otherwise).

Applicant asserts that the current Office Action fails to comply with the requirements of the M.P.E.P. For example, the Examiner has failed to make any mention of the status of claims 6, 7, 16, and 17, contrary to the requirements of M.P.E.P. §707.07(i). The status of claims 6, 7, 16, and 17 is unclear from the current Office Action. The previous office action had indicated that the claims include allowable subject matter, however, the current Office Action lists all claims, 1-26, as rejected. Applicant requests a new office action clearly stating the status of claims 6, 7, 16, and 17, and if the allow-ability of the claims has been withdrawn, a clear explanation of the grounds for rejection as required under the M.P.E.P.

Further, the Office Action does not clearly identify which references, or combination of references, claims 11-12, 14-15 and 19 are rejected over. The Examiner has failed to cite to these claims when presenting the rejections. However, the Office Action does discuss the claims after the discussion of claims 1-2, 4-5 and 9-10. Applicant requests clarification as to the status of claims 11-12, 14-15 and 19, as well as the basis for any rejection of the claims.

Moreover, the rejections of all claims in the current Office Action fail to comply with the requirements of M.P.E.P. § 2112. The Office Action relies on an assumption that the '510 reference teaches a signal that does not contain synchronization information in asserting correspondence with respect to every claim currently rejected. However, the '510 reference never states that either of the asserted signals, SHIFT or MUTE, do not contain synchronization information. The Office Action's position is essentially an argument that the absence of synchronization information is inherent in the MUTE and/or

SHIFT signals. The Office Action fails to provide any support for the Examiner's position that the signals do not contain synchronization information, contrary to the requirements of M.P.E.P. § 2112 ("The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic"). Instead, the Office Action impermissibly places the burden of showing that the signals do contain synchronization information on the Applicant. *See* Office Action page 2. For at least this reason the various rejections of claims 1-26 are improper, and should be withdrawn.

Applicant respectfully traverses the § 103(a) rejections because the cited '006 reference either alone or in combination with the '209 reference and the '510 reference lacks correspondence. For example, none of the asserted references teaches the claimed invention "as a whole" (§ 103(a)) including aspects regarding, *e.g.*, a reader transmitting commands that do not include synchronization information to an RFID transponder. As discussed above, the Office Action has not established the asserted '510 reference teaches a reader transmitting a command signal that does not include synchronization information as required under M.P.E.P. § 2112. Because none of references teach these aspects, no reasonable interpretation of the asserted prior art, taken alone or in combination, can provide correspondence. As such, the rejections fail.

Applicant further traverses the § 103(a) rejections because the cited references teach away from the Office Action's proposed combination. Consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main ('006) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (U.S. 2007) ("[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious."). In this instance, the Office Action erroneously concludes that the skilled artisan would combine teachings of the '209 reference directed to a cordless telephone apparatus with the RFID tags 102 of the '006 reference in order "to reduce power consumption of the RFID device." Applicant notes that the '209 reference does not even mention that power consumption is reduced in its cordless telephone apparatus, but somehow the Office Action concludes that applying these entirely unrelated teachings to

the RFID tags 102 of the '006 reference would reduce power consumption. Applicant submits that the '006 and '209 references teach away from the combination of wholly unrelated teachings (as proposed by the Office Action) based upon mere speculation with regard to the reduction of power consumption.

Moreover, the asserted combination of the '006 reference with the '209 reference and the '510 reference renders the device of the '006 reference inoperable. The Office Action asserts that either the '510 reference's SHIFT signal or the MUTE signal correspond to a command that does not contain synchronizing information. The '510 reference's SHIFT signal tells the transponders to move to the next time period. Adding the SHIFT signal to the '510 reference would affect the Time Slots of the '006 reference and render the Code Division Multiple Access (CDMA) protocol inoperable because it would change the relationship between Time Slot length and coding space required for multiple RFID tags to be recognized in a given Time Slot as required by the '006 reference. *See* Col 13:46- Col 14:46. If the MUTE signal is integrated into the '006 device, it similarly becomes inoperable. The MUTE signal of the '510 reference is used to mute a transponder after it has been identified by the reading device so that it sends no more signals to the reading device. Including the MUTE signal would prevent the tags of the '006 reference from sending the acknowledgment signal required by the '006 device, rendering the '006 reference inoperable. Therefore, the § 103 rejections of claims 1-19 are improper and should be withdrawn.

Applicant further traverses the § 103(a) rejections because the Office Action has improperly relied on an "articulated reasoning" for supporting the proposed combination of references. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in *KSR*). The Office Action states one would be motivated to combine the three references for power saving reasons, without providing any support for such an assertion. The two secondary references, the '209 reference and the '510 reference, fail to mention power savings in connection with their teachings. Further, the '006 reference provides teachings to show that power savings are achieved by the '006 references device. One of skill in the art would not be motivated to look to either the '209 or the '510 reference to solve a problem that has already been

solved in the '006 primary reference. *See, e.g., Ex Parte Rinkevich et al*, Appeal 20071317, decided May 29, 2007. Therefore, because the Office Action has failed to provide a motivation to combine as required under M.P.E.P. § 2141 and relevant case law, the § 103(a) rejections are improper.

In view of the above, the § 103(a) rejections are improper and Applicant requests that they be withdrawn.

Applicant respectfully traverses the § 102(b) rejection of claims 20-26 because the cited '510 reference does not correspond to aspects of the claimed invention directed to a reader transmitting commands that do not include synchronization information to an RFID transponder. The Office Action erroneously asserts that the '510 reference teaches these aspects of the claimed invention because the '510 reference does not mention that the SHIFT and MUTE signals contain synchronization information. Applicant submits that it is improper for the Office Action to assert correspondence to the claimed invention based on the lack of teachings in the '510 reference. As discussed above, under M.P.E.P. § 2112, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." The '510 reference does not teach that the SHIFT and MUTE signals do not contain synchronization information and, as such, there is no correspondence to the claimed invention. Instead, it is a mere possibility that the SHIFT and MUTE signals might not contain synchronization information, and a rejection cannot be based on mere possibilities. *See, e.g., M.P.E.P. § 2112*. Accordingly, the § 102(b) rejection of claims 20-26 is improper and Applicant requests that it be withdrawn.

In view of the above, Applicant believes that each of the rejections is improper and should be withdrawn and that the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Aaron Waxler, of NXP Corporation at (408) 474-9063 (or the undersigned).

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